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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,365	05/23/2006	Naoki Sugawara	03500.103515.	1734
5514 7590 07/23/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER ROBINSON, MYLES D				
ART UNIT 2625		PAPER NUMBER		
MAIL DATE 07/23/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/580,365

Applicant(s)

SUGAWARA, NAOIKI

Examiner

Myles D. Robinson

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1 - 8 and 10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See *Continuation Sheet*.
12. ☐ Note the attached *Information Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625

Continuation of 3. NOTE: The Applicant proposes newly-added claim 11 without canceling a corresponding number of finally rejected claims. Therefore, the proposed amendments filed after the final rejection will not be entered.

Continuation of 11. does NOT place the application in condition for allowance because:

The amended drawings and specification were received on 7/13/2010. These amendments are acceptable.

Applicant's arguments (see Remarks 7/13/2010) have been fully considered but they are not persuasive.

Regarding claims 1, 8 and 10, the Applicant argues that Sugita et al. (U.S. Patent No. 5,570,205) in view of Kawasaki (Japanese Patent No. 07-283894) does not disclose, teach or suggest controlling the carrier path to automatically switch from conveying the original sheet (e.g. for scanning when initiating facsimile transmission) to conveying the recording sheet (e.g. for printing during facsimile reception) after the completion of a reception of first image data. Specifically, the Applicant individually attacks Sugita for not disclosing this claimed feature (see Remarks 7/13/2010 [page 15] and Remarks 1/28/2010 [pages 17 - 18]).

However, Kawasaki does disclose explicitly disclose automatically switching from the conveyance of the original copy sheet during facsimile transmission to the resumption of the printing sheets of a facsimile reception (see Drawing 1 wherein main control section 1 performs the following: 1) interrupts print operation of printer 6 during facsimile reception [paragraph 0016], 2) instructs image reading part 5 to scan manuscript to initiate facsimile transmission [paragraph 0017], 3) temporarily stores scanned fax data in memory 4 to be transmitted [paragraph 0018], and 4) resumes interrupted printing of received facsimile job after completely scanning manuscript for transmission [Abstract, paragraphs 0019 and 0024]).

In addition, Kawasaki teaches that main control part 1 (e.g. CPU) performs the operation processing in connection with ROM 9a, 9b (see Drawing 1 [paragraph 0012]) wherein the CPU performs "concrete control action" (e.g. automatic, user-friendly manner) so that switches S1, S2 can connect freely receive and transmit facsimile jobs simultaneously (Abstract, paragraphs 0005, 0013 - 0014 and 0024). Kawasaki also teaches that the CPU performs in such a manner that the user does not need to be present beside facsimile machine after performing the operation switch in step 101, which suggests to one of ordinary skill in the art that disclosed procedures are performed automatically (see Drawing 2 [paragraph 0020]). The Examiner asserts and maintains that the prior art processor taught by Kawasaki, in its normal and usual operation, would necessarily perform the automatic method claimed. See MPEP §212.02.

Furthermore, with the duly noted exception of automation, the Applicant has already pointed out that Sugita teaches the necessary structure of that of the apparatus claims (see Remarks 1/28/2010 [page 18]). A prima facie case of either anticipation or obviousness has been established whenever the claimed and prior art apparatuses are identical or substantially identical in structure. While features of an apparatus may be recited either structurally or functionally, apparatus claims must be distinguished from the prior art in terms of structure rather than function. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. See MPEP §2112.01 I and §2144.

While the Applicant argues that the automation of the amended claims should overcome the manual activity taught by Sugita, the Examiner argues that broadly providing automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See MPEP §2144.04 III.

Moreover, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the final Office action, the Examiner already agrees with the Applicant that Sugita does not disclose the claimed automatic switching feature (see Office Action 4/20/2010 [pages 8 - 9]). Hence, the Examiner introduced a rationale for prima facie obviousness, which relies upon the prior art disclosed in Kawasaki, in the final rejection dated 4/20/2010 as well as in the previous Office action dated 8/23/2009. The Examiner reiterates the same citations of prior art as well as rationale herein.

Regarding claims 1, 8 and 10, the Applicant argues that Sugita et al. (U.S. Patent No. 5,570,205) in view of Kawasaki (Japanese Patent No. 07-283894) does not disclose, teach or suggest a medium conveying mechanism used for both reading and recording. Specifically, the Applicant individually attacks Kawasaki for not disclosing this claimed feature (see Remarks 7/13/2010 [pages 15 - 16]).

However, Sugita does disclose a medium conveying mechanism used for both reading and recording, or in other words, used in common to convey the original sheet ready by the recording means and for conveying the recording sheet on which the first image data is recorded (see Figs. 2, 6, 7 and 10 wherein driving pulse motor 37 drives driving rollers 13 - 15 to convey original sheet 12 along a common carrier path 11 [Abstract, column 2, lines 1 - 3, 42 - 67 and column 5, line 66 - column 6, line 8] for both reading operations [i.e. scanning, copying] in steps S2 - S9 [column 4, lines 32 - 48] and recording operations [i.e. printing] in steps S'2 - S'11 [column 5, lines 31 - 56]).

Moreover, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the final Office action, the Examiner already agrees with the Applicant that Kawasaki does not disclose the claimed commonly-used medium conveying mechanism for both reading and recording (see Office Action 4/20/2010 [pages 10 - 11]). Hence, the Examiner introduced a rationale for prima facie obviousness, which relies upon the prior art disclosed in Sugita, in the final rejection dated 4/20/2010 as well as in the previous Office action dated

8/28/2009. The Examiner reiterates the same citations of prior art as well as rationale herein.

Claims 1 - 8 and 10 were finally rejected because Sugita and Kawasaki are combinable and are from the same field of endeavor, being facsimile systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Sugita by including simultaneous reception and transmission of facsimile messages. The suggestion/motivation for doing so would have been to make for a more user friendly system and to save the user time of waiting until all the pages of a received fax job have printed in order to initiate sending a fax job, as suggested by Kawasaki (Abstract, paragraphs 0002, 0005, 0023 and 0024). See MPEP §2143 G.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawasaki to include consolidation of two separate conveying mechanisms for scanning and another for printing into one common conveying mechanism for both scanning and printing. The suggestion/motivation for doing so would have been to optimize space and to reduce production costs by miniaturization of the facsimile unit, as suggested by Sugita (Abstract, column 1, lines 13 - 21, 55 - 60 and column 2, lines 1 - 3). See MPEP §2143 G.

Sugita contains a "base" facsimile apparatus comprising a commonly-used medium conveying mechanism for both reading and recording. However, the claimed invention could be seen as an "improvement" over Sugita in that the claimed invention performs an automatic switching conveyance feature upon completion of the reading operation.

Kawasaki contains a known facsimile technique, which is applicable to the "base" facsimile apparatus, for automatically switching medium conveyance upon completion of the reading operation.

The known technique taught by Kawasaki for automatically switching medium conveyance upon completion of the reading operation would have been recognized by one skilled in the art as applicable to the "base" facsimile apparatus taught by Sugita. Not only would have applying the known facsimile technique taught by Kawasaki to the base facsimile apparatus taught by Sugita would have yielded predictable results, the application would have resulted in an improved facsimile system based upon the suggestions/motivations provided above. See MPEP §2143 D.

Automated switching is considered as functional language directed to an apparatus claim. A prima facie case of either anticipation or obviousness has been established whenever the claimed and prior art apparatuses are identical or substantially identical in structure. While features of an apparatus may be recited either structurally or functionally, apparatus claims must be distinguished from the prior art in terms of structure rather than function. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. See MPEP §2112.01 I and §2144.

Therefore, the Applicant's arguments regarding claims 1, 8 and 10 are considered not persuasive, and the proposed amendments will not be entered. Please cite rationale for the grounds of rejection in previous Office actions for further explanation..